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51



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/756,805 | 01/09/2001 | Satoru Kikugawa | 74457/08126 | 6166 |

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SOCAL IP LAW GROUP
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EXAMINER

SHINGLES, KRISTIE D

ART UNIT PAPER NUMBER

2141

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,805

Applicant(s)

KIKUGAWA, SATORU

Examiner

Kristie Shingles

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. JP 2000-48645.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/31/01-05/19/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-12 are pending.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. (JP) 2000-48645 filed on 02/25/00.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 05/31/01, 06/13/03 and 05/19/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the Office. An initialed and dated copy of Applicant's IDS form 1449, is attached to the instant Office action.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: s20. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the

Art Unit: 2141

immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: 100b. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2141

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by van Hoff (USPN 5,822,539).

a. Per claims 1 and 7 (differs only by statutory class), van Hoff teaches an electronic bulletin board system including a server computer with an electronic bulletin board function communicating with at least one user computer via a network for mediating information exchange therebetween, said server computer comprising:

- a database as a notable words collection storing a plurality of words that are appropriately selected, each of the notable words in the database being linked with a corresponding URL (col.4 lines 9-21 and col.10 lines 21-28; cross reference dictionary/directory achieves function of database with text and a URL pointer);
- a logic device inspecting a message text sent from a user computer of a person who wants to post a message by consulting the notable words collection (Abstract, col.4 lines 39-46 and col.5 lines 27-55; annotation proxy server parses documents and uses cross reference to pair and match symbols, words, and characters),
- wherein the inspected message text is posted on the bulletin board when the message text does not include a notable word in the notable words collection (col.10 line 62-col.11 line 22; based on the relevance indicator threshold the document may or may not include any annotations, if not it continues its transmission to the user's browser for viewing); and
- the notable word in the message text is converted into a hypertext format having a URL to which the word is linked as a link destination, and the message text is posted on the bulletin board when the message text includes a notable word in the notable words collection (Fig.3-5 and col.5 line 41-col.6 line 48; upon matching symbols, words, and characters with the cross reference and the document, the hypertext link is added to the document and displays the merged document onto the user's browser for viewing.).

b. Claims 4 and 10 comprise limitations similar to those of claims 1 and 7 and are therefore rejected under the same basis.

Art Unit: 2141

c. Per claims 2 and 5 (differs only by statutory class) van Hoff, teaches an electronic bulletin board system including a server computer with an electronic bulletin board function communicating with at least one user computer via a network for mediating information exchange therebetween, said server computer comprising:

- a first database as a notable words collection storing a plurality of words that are appropriately selected (Fig.1, col.4 lines 9-21 and col.10 lines 21-28; cross reference dictionary/directory achieves function of database with text and a URL pointer);
- a second database storing a plurality of records with text data (Fig.1, col.4 lines 9-21 and col.10 lines 21-28; URL pointer for cross reference directory 2);
- a logic device inspecting a message text sent from a user computer of a person who wants to post a message by consulting the notable words collection (Abstract, col.4 lines 39-46 and col.5 lines 27-55; annotation proxy server parses documents and uses cross reference to pair and match symbols, words, and characters),
- wherein the message text is posted on the bulletin board when the message text does not include a notable word in the notable words collection (col.10 line 62-col.11 line 22; based on the relevance indicator threshold the document may or may not include any annotations, if not it continues its transmission to the user's browser for viewing);
- the second database is searched by using the notable word as a keyword when the message text includes a notable word in the notable words collection, and if the record including the notable word does not exist in the database, the message text is posted on the bulletin board (Fig.1 and col.9 line 59-col.10 line 28; use of different cross reference directories, one type includes link to optional directory generator and based on the matching word search with the cross references along with the relevance indicator threshold, the document may or may not include any annotations, if not it continues its transmission to the user's browser for viewing);
- when the record including the notable word exists as a result of searching the second database, the word in the message text is converted into a hypertext format having a URL generated properly to which the word is linked as a link destination, and the message text is posted on the bulletin board, the URL being so described as to constitute a start instruction to a search report program, which reports a result of searching the first database by using the notable word as a keyword (Fig.1 and col.9 line 59-col.10 line 28; use of different cross reference

Art Unit: 2141

directories, after matching words in one cross reference, another cross reference can be used for hypertext linking), and

- when the URL is sent from a specific user computer, the search report program is executed to return a set of report screen data of the search result to the specific user computer (Abstract, col.2 lines 7-11 and col.10 lines 29-39; URL is activated once user selects it and thus the corresponding search result screen is displayed on user's computer).

d. Claims 8 and 11 comprise limitations similar to those of claims 2 and 5 and are therefore rejected under the same basis.

e. Per claims 3 and 6, van Hoff teaches an electronic bulletin board system according to claim 2, wherein each record stored in the second database is linked with a corresponding URL, and the search report program generates a set of screen data including a hypertext having the URL to which the obtained record is linked as a link destination (Abstract, col.2 lines 7-11, col.4 lines 9-21 and col.10 lines 29-39; URL is activated once user selects it and thus the corresponding search result screen is displayed on user's computer by virtue of hyper-linking includes the URL's hypertext).

f. Claims 9 and 12 include limitations similar to those of claims 3 and 6 and are therefore rejected under the same basis.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2141

- a. Tobin (USPN 6,141,666) teaches a method and system for customizing marketing services on networks communicating with hypertext tagging conventions.
- b. Call (USPN 6,154,738) teaches methods and apparatus for disseminating product information via the internet using universal product codes.
- c. Ikeno (USPN 6,128,635) teaches a document display system and electronic dictionary.
- d. Hill et al (USPN 6,029,192) teach a system and method for locating resources on a network using resource evaluations derived from electronic messages.
- e. Havens (USPN 5,924,072) teaches a knowledge management system and method.
- f. Kikugawa (USPN 6,438,632) teaches an electronic bulletin board system.

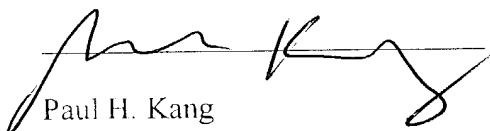
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 703-605-4244. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703-305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kds

A handwritten signature in black ink, appearing to read 'Paul H. Kang', is written over a horizontal line.

Paul H. Kang
Primary Examiner
Art Unit 2141